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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/615,273	07/13/2000	Luc Wuidart	S1022/8394	3658

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EXAMINER

SHIMIZU, MATSUICHIRO

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/615,273

Applicant(s)

WUIDART ET AL.

Examiner

Matsuichiro Shimizu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2003 and 09 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-17 and 19 is/are rejected.
- 7) ☐ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

The examiner acknowledges amended claims 1-2 and 4-10, and new claims 13-19.

The examiner withdraws the objection to figure 1 in view of a proposed drawing correction provided by the applicant filed on 4/14/2003.

The examiner withdraws claim 1 rejection under 35 U.S.C. 112, second paragraph in view of new amended claim 1 provided by the applicant filed on 4/14/2003.

***Arguments***

Applicant's arguments with respect to claims 1-17 and 19 have been considered but are moot in view of the new grounds of rejection. That is; previously allowed dependent claims 4-5 are rejected under 35 U.S.C. 112, first paragraph.

Therefore, rejection of claims 1-17 and 19 follows:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or

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with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 and 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The distance separating the transponder from the terminal becomes smaller than a predetermined value in claims 1,8 and 16-17 (specification-lines 24-26, page 4; lines 27-29, page 5; lines 26-27, page 8) is inconsistent with the distance separating the transponder from the terminal becomes greater than a predetermined value (specification-lines 15-16, page 7; lines 10-12, page 8; line 27, page 8).

Furthermore, the applicant, Wuidart (JP-P2001-86044A) teaches the distance separating the transponder from the terminal becomes greater than a predetermined value (claim1-lines 6-7; claim 9, lines 6-7; section 0026-lines 5-7; section 0045, lines 2-5).

*Claim Rejections – 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Janning et al. (6,446,049).

Regarding claim 13, Janning teaches a system for contactless electromagnetic transmission between a terminal (Fig. 6, col. 6, line 54 to col. 7, line 10, transceiver (22) or interrogator comprising tuned circuit (607) and antenna (609)) and a transponder (Figs. 3 and 5A–C, col. 14, lines 7–57, receptacle transceiver (50) or transponder comprising tuned circuit (307) and antenna (309)) comprising: the

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terminal having a first oscillating circuit (Fig. 7, tuned circuit 607, resistor 701, capacitor 741-742, inductor 772) including a first resistor, a first capacitor and a first inductor; and the transponder having a second oscillating circuit (Fig. 5A, tuned circuit 307, resistor 515, capacitor 537-538, inductor 558) including a second resistor, a second capacitor and a second inductor; wherein at least one of the terminal and the transponder is structurally dedicated to operation in a relation where a distance between the terminal and the transponder exceeds a predetermined distance (col. 9, lines 52-58, minimum distance or predetermined distance is limited by the position of transceiver 50 and dispenser transceiver 22).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janning.

Regarding claims 14-15 and 19, Janning continues, as disclosed in claim 13, to disclose the second capacitor and the second inductance (Fig. 7, tuned circuit 607, resistor 701, capacitor 741-742, inductor 772). But Janning fails to disclose the second capacitor is an integrated capacitor; the second inductance is minimized; and the first inductor includes between 3 and 15 turns.

However, Janning discloses, in the art of transponder system, the second capacitor and the second inductance (Fig. 7, capacitor 741-742, inductor 772). Furthermore, one of ordinary skill in the art recognizes the integrated capacitor is integral of capacitor wherein capacitor is the mathematical design expression; and the minimized inductance and the first inductor includes between 3 and 15 turns is a matter of choice in design through routine experimentation in order to achieve

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optimum operation of transponder system. Therefore, it would have been obvious to a person skilled in the art at the time of invention was made to include the transponder, wherein the second capacitor is an integrated capacitor; and the second inductance is minimized and the first inductor includes between 3 and 15 turns in the device of Janning because Janning suggests the second capacitor and the second inductance and one of ordinary skill in the art recognizes the integrated capacitor is integral of capacitor wherein capacitor is the mathematical design expression; and the minimized inductance and the first inductor includes between 3 and 15 turns is a matter of choice in design through routine experimentation in order to achieve optimum operation of transponder system.

***Allowable Subject Matter***

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The first resistor, the first capacitor and the first inductor are connected in series with one another, and the second resistor, the second capacitor and the second inductor are connected in parallel with one another, as claimed in dependent claim 18, are not taught nor suggested by the prior art of record.



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***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is (703) 306-5841. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on (703-305-4704). The fax phone number for the organization where this application or proceeding is assigned is (703-305-3988).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu



September 7, 2003

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
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